

Interview Summary	Application No. 09/351,778	Applicant(s) Wold et al.	
	Examiner Scott D. Priebe, Ph.D.	Art Unit 1632	

All participants (applicant, applicant's representative, PTO personnel):

(1) Scott D. Priebe, Ph.D. (3) _____
 (2) David L. Parker (4) _____

Date of Interview Apr 24, 2003

Type: a) ☐ Telephonic b) ☐ Video Conference
 c) ☒ Personal [copy is given to 1) ☐ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No. If yes, brief description:

Claim(s) discussed: All in general

Identification of prior art discussed:
Little/Henderson

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

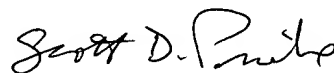
Briefly discussed ways to overcome rejections under 112, 1st. Discussed sufficiency of 131 declaration to overcome Little/Henderson as described in the agenda (attached).

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached

SCOTT D. PRIEBE, PH.D.
PRIMARY EXAMINER
ART UNIT 1632



Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

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REMARKS: Examiner Priebke - This is for our
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David Parker

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Interview Agenda – USSN 09/351,778/Examiner Priebe

April 24, 2003

Discussion of Pending Official Action dated 3/18/03

Interview Attended by Associate Counsel David L. Parker, Reg. No. 32,165

1. Rejections under 35 U.S.C. §112, 1st Para.

Claim 40 – discuss amendments to remove reference to individual E3 elements. In formal response, we will point out specific support.

Claims 45,51 – discuss amendments to address concern regarding “overexpression.” One possibility might be to “DNA encoding ADP, wherein the ADP is positioned to be overexpressed relative to wild-type.” We would appreciate any suggestions.

2. Rejections under 35 U.S.C. §112, 2nd Para.

We don’t fully understand the rejection. Suggestions by the Examiner would be appreciated.

3. Rejections under 35 U.S.C. §102/103 over Tollefson

We would consider focusing further prosecution on claim 13, which would overcome all pending 102 rejections over Tollefson.

Alternatively or additionally, we would consider amending the vector claims to refer to a “pharmaceutical composition.”

4. Rejections under 35 U.S.C. §102 over Henderson/Little.

We would like to discuss 1) evidence of conception contained in the exhibits to 131 declaration(s) of record, and 2) caselaw such as *In re Stempel*, 113 USPQ 77 (CCPA 1957) and *In re Schaub*, 190 USPQ 324 (1976) (copies attached to this fax), which hold that 131 declarations need not demonstrate conception of a genus, only a species of the genus or so much as the prior art shows.

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In re Schaub, Bernady, and Weiss

190 USPQ

Court of Customs and Patent Appeals*In re Schaub, Bernady, and Weiss*

No. 76-593 Decided June 30, 1976

PATENTS**1. Affidavits — Anticipating references (Rule 131) (§12.3)****Patentability — Anticipation — Carrying date back of references (§51.203)**

Showing that applicants viewed invention as embracing series of homologous compounds is unnecessary when it is otherwise established that facts set out in Patent Rule 131 affidavits would persuade one of ordinary skill in art to reasonable certainty that applicants possessed so much of invention as to encompass reference disclosure; fact that reference compound was bracketed by its adjacent homolog and compound that would have been adjacent homolog if it were acid rather than ester, both of which applicants reduced to practice before date of reference, provides "reasonable certainty" that applicants possessed so much of invention as to encompass reference disclosure.

2. Affidavits — Anticipating references (Rule 131) (§12.3)**Patentability — Anticipation — Carrying date back of references (§51.203)****Patentability — Invention — Specific cases — Chemical (§51.5093)**

Compound that applicants reduced to practice before date of reference that disclosed adjacent homolog is sufficient to render reference compound *prima facie* obvious; closeness of another compound, which was reduced to practice before date of reference and would be adjacent homolog of reference compound if it were acid rather than ester, supports conclusion that reference compound is obvious in view of applicant's adjacent homolog.

Particular patents — 3-Alkyl-2-(6-Carboxyhexyl)Cyclopentanones

Schaub, Bernady, and Weiss, 3-Alkyl-2-(6-Carboxyhexyl)Cyclopentanones and Esters and Salts Thereof, rejection of claim 11 of application reversed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Robert Eugene Schaub, Karel Francis Bernady, and Martin

Joseph Weiss, Serial No. 240,814, filed Apr. 3, 1972, continuation in part of application, Serial No. 225,680, filed Feb. 11, 1972. From decision rejecting claim 11, applicants appeal. Reversed.

Jack W. Richards and Edward A. Conroy, Jr., both of Stamford, Conn., for appellants.

Joseph F. Nakamura (Fred E. McKelvey, of counsel) for Commissioner of Patents and Trademarks.

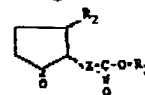
Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.

Rich, Judge.

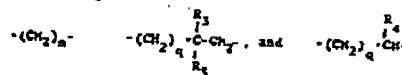
This appeal is from a decision of the Patent and Trademark Office Board of Appeals ("board") affirming the rejection, under 35 USC 102(a), of claim 11 in application serial No. 240,814, entitled "3-Alkyl-2-(6-Carboxyhexyl) Cyclopentanones and Esters and Salts Thereof," filed April 3, 1972, as a continuation-in-part of application serial No. 225,680, filed February 11, 1972. The remaining claims in the application have been allowed or indicated as allowable. We reverse.

The invention relates to substituted 9-oxoprostanoic acids¹ (3-alkyl-2-(w-carboxyalkyl) cyclopentanones) and the esters and cationic salts thereof, said to be useful as antimicrobial agents, hypotensive agents, anti-ulcer agents, or intermediates. Claim 11 to the generic invention reads:

11. A compound selected from the group consisting of those of the formula:



wherein R₁ is selected from the group consisting of hydrogen and lower alkyl; R₂ is a straight chain alkyl group having from 1 to 10 carbon atoms, inclusive; and Z is a divalent radical selected from the group consisting of



¹ "Prostanoic acid" is not a systematic name, but a trivial name denoting the compound from which the natural prostaglandins, a family of pharmacologically important compounds, are considered to be derived.

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14, filed Apr. 14, 1972, b. 11, 1972. 11, applicants

d A. Conroy, Conn., for

McKelvey, of Patents and

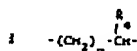
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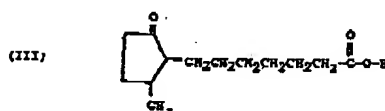
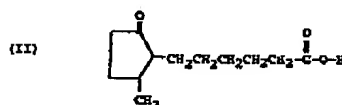
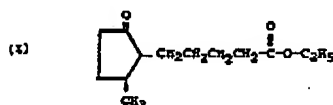
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In re Schaub, Bernady, and Weiss

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wherein m is an integer from 4 to 8, inclusive, q is an integer from 3 to 5, inclusive, R, is lower alkyl, and R, is selected from the group consisting of fluoro and lower alkyl; the stereoisomers thereof; and the cationic salts thereof when R, is hydrogen.

The reference primarily relied on to support the rejection is a published article by Finch et al.: "Cyclopentenone Synthesis by Directed Cyclization," The Journal of Organic Chemistry, Vol. 36, No. 21, 1971, pages 3191-6 ("Finch"). It is conceded that it discloses 2-methyl-5-oxo-1-cyclopentanehexanoic acid, which has the structure of compound (II) below. Appellants have never disputed the §102(a) anticipation of claim 11 by the reference if it is *prior art*; they have, however, sought to antedate the reference by affidavits filed under 37 CFR 1.131 (Rule 131). The examiner conceded that the affidavits establish appellants' actual reduction to practice, prior to Finch, of two other species of the generic invention of claim 11: ethyl 2-methyl-5-oxo-1-cyclopentaneheptanoate, compound (I) below, and 2-methyl-5-oxo-1-cyclopentaneheptanoic acid, compound (III) below.



The examiner, the board, and the solicitor have not disputed these facts but only their legal sufficiency to antedate Finch.

The Board's Decision

The board supported its decision in part by reference to our opinion in *In re Clarke*, 53 CCPA 954, 356 F.2d 987, 148 USPQ 665 (1966):

In commenting on a situation very similar to the one herein, the court in *In re Clarke* * * * stated that a cited reference may be antedated if the facts:

"* * * offered [sic] in a Rule 131 affidavit in support of a general allegation of conception and reduction to practice of the invention, would persuade one of ordinary skill in the art to a reasonable certainty that the applicant possessed so much of the invention as to encompass the reference disclosure * * *."

On the basis of the above cited *Clarke* language, the board held *Clarke* to apply as follows:

Accordingly, if the *only* reasonable interpretation of the facts contained in the noted affidavits is that appellants viewed their invention as embracing a series of homologous acids, we would be constrained to agree that they had antedated the Finch et al. reference compound.

So applying *Clarke*, the board expressed its view as follows:

However, we do not agree that there is only one reasonable conclusion that a worker of routine skill in this field would reach, based upon the available facts.

The board noted that appellants' compounds (I) and (III) had the same empirical formula, a fact to which the board gave great significance:

It will be appreciated that said compounds may be characterized as isomers. Hence, from the evidence, we believe that the skilled worker would be persuaded, to a reasonable certainty, that appellants envisioned their generic invention to concern *isomeric* norprostanoid acid compounds having thirteen carbon atoms. Such isomers would *not* encompass the reference disclosure.

The board stated that "still another interpretation" was suggested by a publication of M. Hamberg, "Metabolism of Prostaglandins in Rat Liver Mitochondria," *European Journal of Biochemistry*, 6, 1968, pp. 135-46 (hereafter "*Hamberg*");

Said item indicates that prostaglandins are subject to betaoxidation in rat liver mitochondria. In vitro experiments showed that the carboxyl side chain of said acid is degraded by one or two C₂ units. Therefore, since the compounds having an even number of carbon atoms in the side chain would seem to approximate naturally occurring compounds in the body, the preparation and testing of such compounds having an even number of carbon atoms in the chain does not, in itself, prove that appellants contemplated all homologous compounds, including those with an odd number of carbon atoms.

Appellants' Arguments

Appellants argue that the disposition of this case should be governed by the following proposition:

In an appropriate case an applicant should not be prevented from obtaining a patent to an invention where a compound described in a reference would have been obvious to one of ordinary skill in the art in view of what the affiant proves was completed with respect to the invention prior to the effective date of the reference.

Like the board, appellants also found their argument on *In re Clarke*, from which the above proposition is a direct quotation.

Appellants contend that the reference compound (compound II) is obvious in view of compounds I and III, which they reduced to practice before the date of the *Finch* reference. They state that they have "bracketed" the reference compound with its two adjacent homologs,² thus raising a "presumption of obviousness vis-a-vis the reference compound," citing *In re Hass*, 31 CCPA 895, 141 F.2d 122, 60 USPQ 544 (1944); *In re Henze*, 37 CCPA 1009, 181 F.2d 196, 85 USPQ 261 (1950); *In re Mills*, 47 CCPA 1185, 281 F.2d 218, 126 USPQ 513 (1960); and *In re Sterniski*, 58 CCPA 1410, 444 F.2d 581, 170 USPQ 343 (1971), so that "one of ordinary skill in the art would be persuaded to a reasonable certainty that Appellants possessed so much of the invention as to encompass the reference disclosure."

Opinion

[1] Appellants' arguments are well founded. If it was not apparent from *In re Clarke* that appellants' proposition applies here, it was made apparent thereafter in *In re Rainer*, 55 CCPA 853, 855-56, 390 F.2d 771, 773-74, 156 USPQ 334, 336-37 (1968):

It is settled, of course, that anticipatory disclosure, not a statutory bar, may be removed as a reference against a generic claim by a Rule 131 affidavit showing

² Appellants recognize that one of their two compounds, compound I, being an ester, is not precisely an adjacent homolog of the reference compound, which is an acid. They argue, however, that the difference between their ester and its acid (which would be an adjacent homolog of the reference compound) is not significant because the acid is "trivially obvious" from the ester. Their argument is an inference from the statement in *Ex parte Korten*, 71 USPQ 173 (8d App. 1945), that "an ester is ordinarily unpatentable over the alcohol from which it is derived."

prior reduction to practice of as much of the claimed invention as the reference shows. *In re Stempel*, 44 CCPA 820, 241 F.2d 755, 113 USPQ 77 (1957). (See further explanation of *Stempel* in *In re Tanczyn*, 52 CCPA 1630, 347 F.2d 832, 146 USPQ 298.) The Patent Office Board of Appeals, in that case, had held such a showing insufficient, requiring, rather, proof of prior "possession of the generic invention." We held that this involved too literal a reading of Rule 131 and that "all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show." And this priority need not always be shown directly. *When that species of the generic invention which has been completed prior to the effective date of the reference would make obvious to one of ordinary skill in the art the species disclosed in the reference, the reference may be said to have been "indirectly antedated."* *In re Clarke*, 53 CCPA 954, 356 F.2d 987, 148 USPQ 665 (1966), 34 G.W.L.Rev. 507, 525 (1966). [Final emphasis ours; footnote quoting Rule 131(a) omitted.]

The board thus gave insufficient consideration to appellants' affidavits when it considered only whether they contained facts showing that "appellants viewed their invention as embracing a series of homologous acids." Such a showing is unnecessary when it is otherwise established that the facts set out in the affidavits are such as "would persuade one of ordinary skill in the art to a reasonable certainty that the applicant possessed so much of the invention as to encompass the reference disclosure." We find such "reasonable certainty" here in the "bracketing" of the reference compound. To our mind it is much more reasonable than the unsupported speculations of the board's arguments which the solicitor's brief makes no effort to support.

[2] Appellants have made a *prima facie* case that the compound of the reference is obvious from the compounds which they made prior to the date of the reference. Appellants' compound III is the next higher homolog of the reference compound II, that is, the two compounds differ by just one CH₂ group in the carboxyl side chain. In both compounds, the carboxyl side chain is a chain of several CH₂ groups terminating in a COOH group. The two compounds are thus adjacent homologs in the classic sense of differing by only one CH₂ group in a hydrocarbon chain. Under these circumstances, compound III is itself sufficient to render the reference compound *prima facie* obvious. *In re Henze*, *supra*; *In re*

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of as much of the reference CCPA 820, 241 7 (1957). (See *Empel* in *In re* 347 F.2d 832, n.1 Office Board had held such a ruling, rather, of the *generic* in- is involved too 31 and that "all ired to show is o much of the the reference is priority need ctly. When that n which has been ide, date of the to one of ordinary disclosed in the said to have been *Larke*, 53 CCPA PQ 665 (1966); (1966). [Final quoting Rule

cient considera- s when it con- tained facts iewed their in- s of homologous necessary when hat the facts set as "would per- in the art to a the applicant ention as to en- sure." We find " here in the : compound. To reasonable than is of the board's or's brief makes

e a *prima facie* the reference is ids which they the reference. the next higher mpound II, that by just one CH₃ chain. In both side chain is a terminating in a pounds are thus classic sense of 3; group in a ler these cir- s itself sufficient mpound *prima* 3; supra; In re

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In re Willis

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Mills, supra. The closeness of appellants' compound I lends further support to the obviousness of the reference compound in view of their compound III. To this *prima facie* showing, the board replied that one of ordinary skill in the art would have concluded that appellants envisioned their invention as a group of compounds isomeric to their compounds I and III. The board pointed to nothing in the record to support its conclusion. The Hamberg publication contains nothing to show that the reference compound would not be obvious from appellants' compounds. Hamberg does not discuss the reference compound at all, and nothing in the record has been pointed to as establishing any relationship between Hamberg and the reference compound.

The decision of the board is reversed.

Court of Customs and Patent Appeals

In re Willis

No. 75-596 Decided July 9, 1976

PATENTS

1. Court of Customs and Patent Appeals — In general (§28.01)

Paper entitled "Notice of Motion to Recall the Mandate" that was filed when there was no appeal before Court of Customs and Patent Appeals in relation to which "motion" might be filed was erroneously titled.

2. Court of Customs and Patent Appeals — In general (§28.01)

Petition for rehearing or for writ of certiorari within 21 days of Court of Customs and Patent Appeals' decision automatically stays court's mandate, but after 21 days mere filing of petition for writ of certiorari has no effect on mandate.

3. Applications for patent — Continuing (§15.3)

Court of Customs and Patent Appeals — In general (§28.01)

Appealed application in which no claims were allowed suffered its demise when mandate of Court of Customs and Patent Appeals, which had affirmed Patent and Trademark Office decision, was received in Patent and Trademark Office, and thereafter there existed no application of which subsequent application could constitute "continuation."

4. Court of Customs and Patent Appeals — In general (§28.01)

Desire to obtain benefit of filing date of appealed application for "continuation" application, asserted by petitioner whose appealed application ceased to exist after Court of Customs and Patent Appeals' mandate, is insufficient as sole justification for recalling mandate.

5. Court of Customs and Patent Appeals — In general (§28.01)

Court of Customs and Patent Appeals has power, in interest of justice, to recall its mandate in appropriate cases, but power should be exercised sparingly and only upon showing of good cause.

6. Affidavits — Anticipating references (Rule 131) (§12.3)

Court of Customs and Patent Appeals — In general (§28.01)

Justice does not require recalling Court of Customs and Patent Appeals' mandate after applicant withheld Patent Rule 131 facts of which he was fully aware and employed processes of Patent and Trademark Office and Court of Customs and Patent Appeals to determine whether he had right to patent without relying on those facts; there is no requirement or rule compelling applicant to file Rule 131 affidavit; applicant who was free to file continuation to assert Rule 131 facts before Court of Customs and Patent Appeals' mandate issued and application suffered its demise but who elected to expend scarce judicial resources while failing to take timely action is not entitled to mandate's recall.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Nathaniel C. Willis, Sr., Serial No. 30,543. On petition to reconsider and grant motion recalling mandate. Petition denied.

William T. Hough, and Polachek, Saulsbury & Hough, both of Basking Ridge, N.J., for petitioner.

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In re Stempel

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nothing from may be fairly ach a composi- considered to be nt appellants'

ing the composi- ld, it would not pealed claims, to the use of

nals relied upon Goldschmidt as vine flour in a hat patent dis- sition composed particles of oli- he patent states h material may ide of fine partic- es that such a because of "the ausing silicosis

ne particles de- nidt patent may ag a flour, there- ing such a flour r even with the f which the mold ary, the patentee te the fine and use them in dif- mold.

was designed pri- molding of metals react with silica; completely elimi- e idea of a compo- ned by appellants, silica sand, is en- dschmidt's inven-

idit's reference to ie silicosis hazard sence of minerals g foundry workers, " whereas appel- sists principally of a form of quartz. stent contains no act that it is the a which constitute s hazard and that ily be used if fine i of silica flour are

iven, we are of the schmidt patent fails f olivine flour as an and molding compo- the Dietert patent, unbinded with Gold- the appealed claims, that silica flour is its mechanical prop- acts chemically with

the other ingredients. Thus the patent states that

" * * * It is quite likely that the silica flour reacts with clay constituents to form refractory silicates. These silicates also possess cementing properties which possibly account for the greater hot strength of mold obtained. * * *

Since silica flour is relied on for its chemical action, it would not be obvious that olivine flour, which differs materially from silica flour chemically, would form an acceptable substitute for it in Dietert's composition.

While the prior art shows that silica sand, western bentonite, and olivine are all old ingredients in molding compositions, it does not suggest the use of those ingredients in a single composition in the proportions stated in the appealed claims. Appellants' specification clearly indicates that the claimed composition has definite advantages, not only in reducing the silicosis hazard, but in improving other properties of the composition, and it was conceded by the board that "the properties of the claimed composition are superior to those of the composition disclosed in Dietert." Since appellants have produced a substantially improved composition by making an unobvious combination of ingredients, the appealed claims should have been allowed.

The decision of the Board of Appeals is reversed.

JACKSON, Judge, retired, recalled to participate in place of Cole, Judge, absent because of illness.

RICH, Judge, Concurring, in which JACKSON, Judge, joins.

I agree that the rejection of the claims should be reversed but my view of the prior art is this:

The Dietert reference clearly teaches a molding sand composed of silica sand, bentonite and silica flour in the proportions claimed. The first two ingredients are conventional. This reference teaches the addition of silica flour to overcome disadvantages in using cheaper and more readily available clays than bentonite, such as montmorillonite, but, far from precluding the use of bentonite, he concludes his specification by saying in effect that any clay suitable for foundry use may be used.

The British Goldschmidt patent, however, fails to suggest the substitution of olivine flour for the silica flour in the Dietert patent composition. It teaches the use of a mold body made entirely of granular olivine, from which fines in the flour category have been carefully re-

moved, and bound with a suitable clay such as bentonite. His mold contains no silica sand at all. The fines he has removed, or fines otherwise produced and fine enough to be called flour, are then made into a slurry and painted on the mold as a facing. I do not see how this would suggest the incorporation of olivine flour in a silica sand and bentonite molding composition.

I regard the avoidance of the silicosis hazard as merely an obvious advantage attendant upon the avoidance in the foundry of materials which produce it. While this occupational hazard may have been an incentive which led to the making of the invention, I cannot see that it should be taken into account in determining patentability. Applicant has not discovered either the cause of nor a cure for silicosis. Patentability should not be predicated to any degree on the fact that olivine does not cause silicosis for the further reason that this fact is disclosed by Goldschmidt.

44 C.C.P.A. (Patents) 820

Court of Customs and Patent Appeals

In re STEMPEL

Appl. No. 6245 Decided Feb. 21, 1957

PATENTS

1. Affidavits — Anticipating references (§ 123)

When domestic patent discloses, but does not claim, only a single species of invention, it cannot be used as basis of rejection of applicant's generic claims where applicant submits Rule 131 affidavit showing completion of invention of that species prior to effective date of reference.

2. Affidavits — Anticipating references (§ 123)

All applicant can be required to show by Rule 131 affidavit is priority with respect to so much of claimed invention as reference shows; when he has done that he has disposed of reference; it is too literal construction of Rule to hold that the invention, the completion of which must be shown by affidavit, is the invention defined in claim the applicant is asking for and, if it is generic claim, prior completion of generic invention must be shown, whether or not reference discloses generic invention.

3. Patent grant—In general (§ 50.01)

Patent statutes give to inventors the right to patent upon compliance with their provisions; neither Patent Office Rules nor interpretation placed upon them can detract from these rights.

4. Patent grant—In general (§ 50.01)

Under 35 U.S.C. 102, applicant is entitled to patent unless it is shown that one of prohibitory provisions therein, or elsewhere in statute, applies.

5. Patentability—Anticipation—In general (§ 51.201)

Patentability—Anticipation—Carrying date back of references (§ 51.203)

Reference is valid only for what it discloses; if applicant establishes priority as to that disclosure, and there is no statutory bar, it is of no effect.

6. Affidavits—Anticipating references (§ 12.3)

Patentability—Anticipation—In general (§ 51.201)

Words and phrases (§ 70.)

"Reference" is nothing more than patent or publication cited to show that all or part of invention for which patent is sought was in prior art, either more than year before filing date to which applicant is entitled, in which case it is "statutory bar" and cannot be sworn back of, or before applicant's date of invention.

7. Affidavits—Anticipating references (§ 12.3)

Patentability—Anticipation—Carrying date back of references (§ 51.203)

When reference is not a statutory bar, Rule 131 provides procedure by which applicant is permitted to show that his date of invention was earlier than date of reference; Rule must be construed in accordance with rights given to inventors by statute; this excludes construction permitting further use of reference as ground of rejection after all pertinent subject matter in it has been antedated to satisfaction of Patent Office.

Particular patents—Benzenes

Stempel, Nuclear Disubstituted Isopropenyl Benzenes, claims 1 to 4, 12, 14, and 15 of application allowed.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Guido H. Stempel, Jr., Serial No. 145,590; Patent Office Division 81. From decision rejecting claims 1 to 4, 12, 14, and 15, applicant appeals. Reversed.

FRANK S. GREENE (McCoy, GREENE & TE GROTENHUIS and WILLIAM C. MC-

Coy, Jr., of counsel) all of Cleveland, Ohio, for appellant.
CLARENCE W. MOORE (J. SCHIMMEL of counsel) for Commissioner of Patents.

Before JOHNSON, Chief Judge, and WORLEY, RICH, and JACKSON (retired), Associate Judges.

RICH, Judge.

This is an appeal from the decision of the Patent Office Board of Appeals in which it affirmed the primary examiner's rejection of claims 1-4, 12, 14 and 15, and reversed the examiner as to claim 18, which claim was allowed.

Claims 1 and 18 are representative:

1. An isopropenyl benzene having only two substituents both of which are attached directly to the nuclear carbon atoms and neither of which are attached to carbon atoms next adjacent that carrying the isopropenyl group; said substituents being further characterized in that they are both orthopara directing groups which do not appreciably activate the benzene ring, said isopropenyl benzene being further characterized in that it is free from more than 20 per cent of unpolymerizable impurities.

18. 3,4-dichloro-isopropenyl benzene said isopropenyl benzene being further characterized in that it is free from more than 20 per cent of unpolymerizable impurities.

We need not discuss the invention beyond pointing out that the application contains broad or generic claims to certain isopropenyl benzenes, such as claim 1, and also specific claims, such as claim 18 to species within the scope of the broad claims. Claims 1-4 and 14 are the broad claims. Claims 12 and 15 are under rejection as to non-elected species and are not before us.

The parties to this appeal are in agreement that there is no dispute as to the facts, which present for our consideration a single question of law. This question, as we shall show, is one on which there is today, as the Solicitor for the Patent Office stated at the hearing, a difference of opinion in the Board of Appeals which our decision in this case should resolve.

These are the pertinent facts:

1. Only one reference is relied on, the United States patent to Amos et al., No. 2,486,379, issued November 1, 1949 on an application filed July 22, 1946.

2. The Amos et al. patent discloses but does not claim the compound "alpha-methyl-3, 4-dichlorostyrene" which is the same thing as 3, 4-dichloro-isopropenyl benzene, the compound of

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particular species." He was allowed a claim to that species. But on the appeal he was asking for broader claims, the subject matter of which the Board held to be *substantially shown in the reference*. Thus all pertinent subject matter in the reference had not been antedated and it was still a good reference against the broad claims.

In *Ex parte Young* an affidavit was accepted as establishing prior invention of a "particular species," but was held not to establish *priority* as to claimed generic subject matter. It is impossible to tell from the opinion how much pertinent disclosure the reference contained other than that which was covered by the showing of the affidavit, but it is obvious that it was considerable. That being so, *there was still anticipatory matter in the reference, not antedated*, by reason of which it could remain a good reference.

The decisions reached on the facts presented in these three Board decisions relied on in this case are, therefore, not, on the basis of their facts, precedents for the decision of the Board in this case.

Of the cases relied on by the Board we have left for consideration the decision of this court in *In re Steenbock*, supra. Notwithstanding its repeated citation by the Board in cases involving swearing-back affidavits, as a controlling authority for what they must contain to support generic claims, we are unable to see that the opinion either says anything about or makes any holding on this point. To be sure, it refers to the facts that some specific claims had been allowed as a result of a Rule 75 affidavit, but that affidavit had nothing whatever to do with the broad claims on appeal. All of those claims were rejected because there was no supporting disclosure in any of the copending earlier applications on which the appellant was attempting to rely and consequently each of three references constituted a statutory bar, having been published more than two years prior to the filing date of the involved application.

The much quoted statement from this court's opinion in *In re Steenbock* was nothing more than a reiteration of the then well-established rule that, in composition of matter cases, "the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining generic claims, although the disclosure in an application of a species may not be sufficient basis for a generic claim," (which seems to be an unnecessary confusion of two distinct propositions of law). The metamorphosis of

this statement, through repeated application to unrelated problems without due regard to the circumstances of its origin, into the proposition here applied by the Board that a Rule 131 (or 75) affidavit, to support generic claims, "must show as much as the minimum required by [of] a patent specification to furnish such support," without any regard for what the reference sworn back of discloses, is wholly unwarranted.

As far as the cases relied on by the Board are concerned, we hold that they do not support its affirmance of the rejection of applicant's broad claims on the Amos et al. reference, all pertinent disclosure in that reference having been antedated.

An earlier Board decision than those considered above which is in accord with our view is *Ex parte Clark*, 60 USPQ 72, 73, (Bd. App. 1943), cited by neither party, wherein, as here, an examiner held a Rule 75 affidavit inadequate to overcome rejection of a generic (Markush) claim on a reference disclosing only one species which the affidavit had antedated, citing *In re Steenbock*, supra. In reversing, the Board said, "it was only necessary for applicant to overcome the disclosure of that patent to *eliminate it as a reference*." (Emphasis ours.) It correctly distinguished *In re Steenbock* on the ground that the refusal of generic claims in that case was "For lack of disclosure in the specification rather than lack of showing in the affidavit under Rule 75." To the same effect is *Ex parte Clifford*, 34 USPQ 232, (Bd. App. 1936, prior to *In re Steenbock*); see especially the concurring opinion of Thurber, Examiner in Chief, whose dissenting opinion in *Ex parte Sebrell*, 36 USPQ 80 (Bd. App. 1937), may have contributed to the schism which has developed in the Board. In this dissent he pointed out that when a reference has a generic disclosure, then the affidavit to overcome it should show prior completion of the generic invention to support a generic claim.

There appears to be another basis for the Board's conclusion beside the "prevailing authority," which we have just found to be non-existent, and that is the wording of Rule 131 itself. This point is not clearly brought out in the Board's opinions in this case, but that it is lurking there is evident from what the Board has said on previous occasions in the cases cited by it and in the Board's statement that "the showing must show a reduction to practice of the *claimed invention*." (Emphasis in original.) It is also implicit in the statement, "It is our conclusion from the record presented that appellant was not

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in possession of the generic invention at a time prior to the effective date of Amos et al." Wherefore we deem it prudent to express our views on this point, especially since it was argued by the Patent Office Solicitor.

Rule 131, insofar as applicable here, reads:

When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, * * * and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, * * * then the patent * * * cited shall not bar the grant of a patent to the applicant, unless the date of such patent * * * be more than one year prior to the date on which the application was filed in this country. (Emphasis ours.)

[2] What the Board is here saying, in effect, is that the invention, the completion of which must be shown by a Rule 131 affidavit, is the invention defined in the claim the applicant is asking for and, if it is a generic claim, prior completion of the generic invention must be shown, whether or not the reference discloses the generic invention.

We think this is a too literal construction of the rule and not in accord with past practice. See Ex parte Burt and Ex parte Clifford, supra. We are convinced that under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the references happens to show. When he has done that he has disposed of the reference.

[3] The patent statutes give to inventors the right to a patent upon compliance with their provisions, and neither the rules promulgated by the Patent Office nor the interpretation placed upon them can detract from these rights. 35 U.S.C. 6. Under 35 U.S.C. 102 an ap-

[4] plicant is "entitled to a patent unless" it is shown that one or another of the prohibitory provisions therein, or elsewhere in the statute, applies. In the case of a reference, it is [5] fundamental that it is valid only for what it discloses and if the applicant establishes priority with respect to that disclosure, and there is no statutory bar, it is of no effect at all.

[6] What is a "reference"? It is nothing more than a patent or publication cited to show that all or part of the invention for which a patent is sought was in the prior art, either more than a year before the filing date to which the applicant is entitled, in which

case it is a "statutory bar" and cannot be sworn back of, or before the ap-
[7] plicant's date of invention. When a reference is not a statutory bar, Rule 131 provides a procedure by which the applicant is permitted to show, if he can, that his date of invention was earlier than the date of the reference. The rule must be construed in accordance with the rights given to inventors by statute and this excludes a construction permitting the further use of a reference as a ground of rejection after all pertinent subject matter in it has been antedated to the satisfaction of the Patent Office.

For the foregoing reasons the decision of the Board of Appeals is reversed.

JACKSON, Judge, retired was recalled to participate in place of COLZ, Judge, absent because of illness.

44 C.C.P.A. (Patents) 789

Court of Customs and Patent Appeals

In re PENNINGTON

Appl. No. 6250 Decided Feb. 21, 1957

PATENTS

1. Patentability — Anticipation — Combining references (§ 51.205)

Where two or more prior art references are combined to negative patentability, test applied is whether prior art suggests doing what applicant did; it must be considered whether one skilled in art, with references before him, could have made combination of elements claimed without exercise of invention.

2. Patentability—Evidence of—In general (§ 51.451)

In many cases, invention may consist in one or both of (1) conception of general result wished for, and (2) actual means of achieving that result; hence, that applicant's modifications over prior art might not produce what would normally be termed to be new and unexpected results is not determinant inasmuch as essential portion of applicant's contribution was appreciation that maximum efficiency of prior art devices could not be obtained due to specific cause; once having appreciated this problem, it might be that one skilled in art would construct applicant's apparatus without further use of inventive faculty, but